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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/773,393 | 01/31/2001 | Gregory Warren Goodknight | 2705-155 | 4235 |
| 20575 | 7590 | 05/18/2004 | EXAMINER | |
| MARGER JOHNSON & MCCOLLOM PC 1030 SW MORRISON STREET PORTLAND, OR 97205 | | | MILLS, DONALD L | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2662 | 3 |
| DATE MAILED: 05/18/2004 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|----------------------------|-------------------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/773,393 | GOODKNIGHT, GREGORY WARREN |
| | Examiner Donald L Mills | Art Unit 2662 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 31 January 2001.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-21 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 2. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 12-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 12 and 21, the claim specifies *altering the communication session* (See claim 12, line 10.) It is unclear from the context of the claim what the term “altering” means.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-6, 9-13, and 15-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Thornton et al. (US 6,363,065 B1), hereinafter referred to as Thornton.

Regarding claims 1 and 11, Thornton discloses a voice-over-IP gateway, which comprises:

A converter operable to convert a packet data stream to a public switched telephone network data stream (Referring to Figure 1, the gateway will route the packets through the PSTN, inherently converting the packets for transmission over the circuit switched network. See column 11, lines 1-4.)

A controller operable to (Referring to Figure 2, the gateway utilizes microcontroller 240.):

Send signals in the public switched telephone network data stream identifying the network device as a packet device (Referring to Figure 1, packets are transmitted over the PSTN after the originating IP based device has its destination IP address translated by the gateway. See column 11, lines 1-4.)

Receive signals indicating at least one other network devices are participating in a public switched transmission session with the network device (Referring to Figure 1, the IP destination device receives the call initiation via the gateway. See column 11, lines 1-4.)

Send the packet data stream across the public switched transmission network directly to the at least one other network device (Referring to Figure 1, voice data is exchanged by the originating and destination IP devices over the PSTN via the gateways. See column 11, lines 1-4.)

Regarding claim 2, Thornton discloses *the network device as a voice gateway* (Referring to Figure 1, the gateway will route the packets through the PSTN. See column 11, lines 1-4.)

Regarding claim 3, Thornton discloses *the packet data stream further comprising coded voice* (Referring to Figure 1, the packets are encoded voice traffic. See column 10, line 63.)

Regarding claim 4, Thornton discloses *the packet data stream further comprising data* (Referring to Figure 1, the packets are encoded voice traffic. See column 10, line 63.)

Regarding claim 5, Thornton discloses *the converter further comprising a voice coder/decoder* (Referring to Figures 1 and 2, the gateway utilizes a DSP to covert compressed telephony signals. See column 14, lines 22-25.)

Regarding claim 6, Thornton discloses *the converter further comprising a modem* (Referring to Figures 1 and 2, the gateway inherently acts as a modem by transmitting digital data signals over the analog PSTN.)

Regarding claim 9, Thornton discloses *the controller is a processor configured to execute all the control operations* (Referring to Figure 1, the gateway will route the packets through the PSTN, inherently responsible for executing the call-setup and brake-down. See column 11, lines 1-4.)

Regarding claim 10, Thornton discloses *the controller further comprising more than one integrated circuit* (Referring to Figure 2, the gateway utilizes eight separate DSPs $225_1, \dots, 225_8$. See column 14, lines 9-10.)

Regarding claims 12 and 21, Thornton discloses a voice-over-IP gateway, which comprises:

Establishing a communication session between a first network device and other devices across a public switched telephone network by transmission of a public switched telephone network data stream (Referring to Figure 1, the gateway will route the packets through the PSTN for communicating IP based devices, inherently converting the packets for transmission over the circuit switched network. See column 11, lines 1-4.)

Using transmission of identifying signals to identify at least one other network device participating in the communication session (Referring to Figure 1, packets are transmitted over the PSTN after the originating and destination IP based device have their IP addresses translated by the gateway. See column 11, lines 1-4.)

Altering the communication session between the first network device and the at least one other network device to transmit a packet data stream (Referring to Figure 1, depending on the quality of service needed to support voice traffic the gateway will route the packets through the data network, inherently transmitting a packet signal. See column 10, lines 65-67.)

Regarding claim 13, Thornton discloses *dialing out of a packet domain to a public switched telephone network domain* (Referring to Figure 1, the gateway will route the packets through the PSTN for communicating IP based devices, inherently dialing out of the packet domain to transmit data over the PSTN. See column 11, lines 1-4.)

Regarding claim 15, Thornton discloses *eliminating a conversion through a voice coder/decoder* (Referring to Figure 1, depending on the quality of service needed to support voice traffic the gateway will route the packets through the data network, inherently avoiding a conversion through the voice coder/decoder required for transmission over the PSTN. See column 10, lines 65-67.)

Regarding claim 16, Thornton discloses *eliminating a conversion through a modem* (Referring to Figure 1, depending on the quality of service needed to support voice traffic the gateway will route the packets through the data network, inherently avoiding the digital-to-analog conversion required by the gateway to transmit signals over the PSTN. See column 10, lines 65-67.)

Regarding claim 17, Thornton discloses *gathering information on the at least one other network device and storing the information for future use* (Referring to Figures 1 and 2, the gateway inherently utilizes a routing table which corresponds IP addresses to network devices.)

Regarding claim 18, Thornton discloses *accessing a storage of known network devices based upon the identifying signals; locating information about the at least one other network device; and using that information in altering the communication session* (Referring to Figures 1 and 2, the gateway inherently utilizes its internal routing table to correspond IP addresses to network devices in order to resolve IP destination addresses for communication IP based devices when routing data through the data network.)

Regarding claim 19, Thornton discloses *the first network device sending the identifying signals* (Referring to Figure 1, packets are transmitted over the PSTN after the originating IP based device has its destination IP address translated by the gateway. See column 11, lines 1-4.)

Regarding claim 20, Thornton discloses *the first network device receiving and responding to identifying signals sent by another network device* (Referring to Figure 1, the IP destination device receives the call initiation via the gateway and voice data is exchanged by the originating and destination IP devices over the PSTN via the gateways. See column 11, lines 1-4.)

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 7 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thornton et al. (US 6,363,065 B1), hereinafter referred to as Thornton, in view of Sebestyen (US 5,847,752).

Regarding claims 7 and 14 as explained above in the rejection statements of claims 1 and 12, Thornton discloses all of the claim limitations of claims 1 and 12 (parent claims). Thornton does not disclose *the controller utilizing ITU V.8 protocols*.

Sebestyen teaches a method for call setup and control of video-telephone communication utilizing the ITU-T V.8 signaling protocol (See column 10, lines 19-24.)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the video-telephone communication utilizing ITU-T V.8 signaling protocol of Sebestyen in the system of Thornton. One of ordinary skill in the art would have been motivated to do so in order to connect via analog or digital interfaces and maintain sufficient quality of service for the transmission of the signal.

7. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thornton et al. (US 6,363,065 B1), hereinafter referred to as Thornton.

Regarding claim 8 as explained above in the rejection statement of claim 1, Thornton discloses all of the claim limitations of claim 1 (parent claim). Thornton does not disclose *the controller using robbed-bit signaling*.

Thornton teaches a voice-over-IP telephony gateway which utilizes call independent signaling over conventional H.323 messages.

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It would have been obvious choice in design to one of ordinary skill in the art at the time the invention was made to implement robbed-bit signaling in the system of Thornton. One of ordinary skill in the art would have been motivated to do so in order to efficiently utilize the transmission bandwidth for signaling, voice band, and digital data traffic.

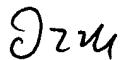
Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Mills whose telephone number is 703-305-7869. The examiner can normally be reached on 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hassan Kizou can be reached on 703-305-4744. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Donald L Mills



May 1, 2004



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